

### REMARKS

Claims 1-7 stand rejected, Claims 8-27 are withdrawn, Claims 28- 32 are added. Claims 1-7 and 28-32 remain pending.

Support for added Claims 28-32 is found in the specification and drawings as originally filed. For instance, Claim 12 as originally filed and the supporting drawings disclose a non-pneumatic drive that translates and rotates the cutter. Claim 15 and the specification and drawings support a claim directed to a piston. With respect to new Claim 31, Page 14 of the specification explains that cutter distal end advances to a second position distal of the distal end of the tissue receiving port 104c. Claim 32 recites a second mechanism for advancing the distal end of the cutter to a position distal of the lateral tissue receiving port (as disclosed in paragraph [0077] of page 14 of the specification. No new matter is added.

#### Restriction Requirement:

Applicants confirm election of Claims 1-7 and adds Claims 28-31 which depend from the elected claims.

#### 102 Rejection

Claims 1-4 are rejected as anticipated by US Publication 2001/0007925 (Ritchart et al.). It is respectfully urged that this rejection is improper for at least the following reasons.

First, with respect to Claim 1, it is respectfully urged that the Examiner has mischaracterized Ritchart as showing a first mechanism [0055] for advancing a cutter to a position proximal of a lateral tissue receiving port, and a second mechanism [0056] for advancing the cutter distal of the position proximal of the lateral tissue receiving port.

Referring to paragraph [0055] of Ritchart relied upon by the examiner, Ritchart explains that in addition to rotation of the cutter 22, the cutter 22 may also be driven to travel axially both distally and proximally. Then, referring to paragraph [0056] of Ritchart, to which the Examiner also refers, Ritchart explains that a piercing mechanism functions to rapidly advance the *entire needle assembly 18* distally in order to locate the tip of the piercing needle 20 at the desired site. At paragraph [0052], Ritchart explains that the needle assembly 18 includes the outer piercing needle 20 and the inner cutter 22. Accordingly, it is respectfully urged that the piercing mechanism in paragraph [0056] of Ritchart does not support the Examiner's rejection.

It is respectfully urged that the piercing mechanism Ritchart describes in paragraph [0056] is not correctly characterized by the Examiner as a second mechanism for advancing the cutter distal of the position proximal

of the lateral tissue receiving port. This is because, if the entire needle assembly (both needle 20 and cutter 22 of Ritchart) is advanced by the piercing mechanism, as described by Ritchart, then the Examiner cannot correctly conclude that this portion of Ritchart discloses that the cutter would be advanced distal of the position proximal of the lateral tissue receiving port, as maintained by the Examiner.

With respect to Claim 2, the Examiner states that the first mechanism employs a pressure differential for advancing the cutter 22, and the Examiner refers to paragraphs [0060] and [0059]. However, Paragraph 0059 of Ritchart discloses advancing and retracting the outer piercing needle 20 by spring force, or alternatively solenoids, pneumatic cylinders. However, it is respectfully urged that the Examiner has not shown where Ritchart teaches or suggest that a pneumatic cylinder is used as a first mechanism to advance the cutter to a position proximal of the lateral tissue receiving port.

Ritchart at paragraph [0060] discloses that a vacuum source is actuated to apply a vacuum as the cutter is retracted proximally. Ritchart explains that the vacuum provides a region of low pressure within the outer needle in the vicinity of the tissue receiving port 28 and through the vacuum lumen 35, and that this facilitates prolapse of the tissue into the piercing needle. (see last three sentences of paragraph [0060])

Accordingly, it is respectfully urged that the Examiner has misapplied Ritchart in rejecting Claims 2 and 3, and that Ritchart does not teach or suggest a first mechanism employing a pressure differential or pneumatics for advancing a cutter to a position proximal of a lateral tissue receiving port.

With respect to Claim 4, the Examiner seems to maintain that the equivalent "second mechanism" is found in paragraph [0056] of Ritchart. As explained above, paragraph [0056] of Ritchart describes a piercing mechanism that functions to advance the entire needle assembly 18 distally. Accordingly, it is respectfully urged that this piercing mechanism does not teach or suggest the subject matter of Claim 1, or the additional limitation in claim 4 that the second mechanism rotates and advances the cutter.

With respect to Claim 4, the Examiner also refers to paragraph [0028] of Ritchart as disclosing a second mechanism that rotates and advances the cutter. Paragraph [0028] of Ritchart is the description of Figure 11 and states that Figure 11 illustrates simultaneous rotation and distal advancement of the cutter to cut off a tissue sample. However, it is respectfully urged that this description of Figure 11 in paragraph [0028] does not teach or suggest a first mechanism for advancing the cutter to a position proximal of the lateral tissue receiving port, and a second mechanism for advancing the cutter distal of the position proximal of the lateral tissue receiving port, wherein the second mechanism rotates and advances the cutter.

103 Rejections:

Claims 5-7 are rejected as obvious over Ritchart in view of US 6,638,235 (Miller et al.). This rejection is improper for the following reasons.

First, the rejection is improper for the reasons set forth above with respect to Claim 1 and Ritchart.

Second, it is respectfully urged that the Examiner has not provided a prima facie case of obviousness. The Examiner is required to provide teaching or suggestion in the prior art for combining the references in the manner suggested by the Examiner. In the office action of December 8, 2005, it is respectfully urged that the Examiner has not provided such motivation in the prior art, but instead merely states:

"It would have be obvious to one having ordinary skill in the art at the time the invention was made in view of Miller et al. to advance the first mechanism at a faster rate than the second mechanism with Ritchart et al. in order to provide a cleaner and better-controlled cut of the biopsy tissue."

It is respectfully urged that the Examiner has not provided motivation in the prior art for modifying Ritchart by the selected teaching of Miller et al., but has merely provided a statement as to why one in the art *might try* such a combination. It is respectfully urged that the case law has rejected such an "obvious to try" standard with respect to rejections under 35 USC 103, and that according to MPEP Section 2143.01, obviousness can only be established where the motivation for the combination or modification is found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

Conclusion:

The Examiner is respectfully requested to reconsider and allow the pending claims. The Examiner is respectfully asked to call the undersigned if the Examiner would like to discuss any of the above Remarks.

Respectfully submitted,

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